

The examiner takes the position that the inner tube 12 of the magnetorheological twin-tube damper 1 embodiment of figure 1 of Wulff has an imperforate sidewall on the grounds that, “If there was an orifice the inventor would have depicted it in the figure.” The examiner takes this position even though most of the sidewall of the inner tube 12 is hidden (or otherwise not shown) in figure 1. The examiner takes this position even though the inner tube 202 (Wulff calls it a pressure pipe) of the shock absorber embodiment of figure 10 of Wulff does not have an imperforate sidewall but has an orifice 210 (see fig. 10 and column 6, line 47). The examiner takes this position even though there is no teaching anywhere in Wulff that the sidewall of any inner tube embodiment is imperforate and there is a teaching in figure 10 of Wulff of an inner tube embodiment with a sidewall having an orifice. The examiner takes this position even though the examiner later cites the Jensen patent in rejecting claim 15, wherein column 6, lines 49-51 of Jensen state, “... fluid communication is provided between a chamber 46 below the cylinder end 44 and the reservoir 40”, and wherein no figure in Jensen shows any orifice providing fluid communication between the chamber 46 and the reservoir 40. Applicants argue that the examiner’s reasoning does not support the examiner’s conclusions and that the examiner has failed to show a prior art teaching of an inner tube of a magnetorheological damper having an imperforate sidewall as required by applicants’ claims 1 and 6 (from which all of applicants’ other claims depend).

The examiner takes the bottom valve subsidiary component of the figure 10 shock absorber embodiment of Wulff and adds it to the figure 1 damper embodiment of Wulff. The examiner does this even though Wulff teaches (see column 6, lines 27-30) only that a figure 10 component may, if appropriate, be considered to be interchangeable with a figure 1-9 component and even though the figure 10 bottom valve cannot appropriately replace any component in the figure 1 damper embodiment. Adding a new figure 10 component (e.g., the bottom valve) to figure 1 is not found in, and appears contrary to, the teaching of Wulff who teaches only component replacement of a figure 1 component with an appropriate figure 10 component.

The examiner’s reasoning for adding the figure 10 bottom valve to figure 1 is that, “The present invention is seen as figure 1 and the bottom valve is used as a subsidiary component in figure 1” and that “column 3, line 25 states, ‘subsidiary components, including a bottom valve,

with which the present invention could be employed””. The complete sentence of the column 3, line 25 citation is, “FIG. 10 illustrates a shock absorber having subsidiary components, including a bottom valve, with which the present invention could be employed.” This means that the figure 10 shock absorber could employ the figure 1 invention, that the figure 10 shock absorber has subsidiary components in addition to the figure 1 invention components, and that such subsidiary components include a bottom valve. Wulff, in this citation, is not teaching that a subsidiary component of figure 10 can be used in figure 1. Elsewhere (see the previous paragraph), Wulff does teach that a figure 10 component can replace an appropriate figure 1 component (such as a figure 10 outer tube replacing a figure 1 outer tube). Adding a figure 10 subsidiary component (i.e., a component found in figure 10 but not in figure 1) to figure 1 is not found in, and appears contrary to, the teaching of Wulff who teaches that the figure 10 shock absorber contains the figure 1 invention and that (from the previous paragraph) a figure 1 component can be replaced by an appropriate figure 10 component. Applicants argue that the Examiner has failed to show a prior art teaching of a valve providing fluid communication of the outer tube with the inner tube in a magnetorheological damper having an imperforate sidewall as required by applicants' claims 3-4 and 13-14.

The examiner's rejection of claim 15 as being “obvious”, under 35 U.S.C. 103, is respectfully traversed. The examiner rejects this claim as being unpatentable over Wulff in view of Jensen (US 5,333,708). Claim 15 depends indirectly from claim 6 through intervening claims 8, 10, 13 and 14. Applicants' previous discussion as to the patentability of claims 6, 13 and 14 over Wulff is herein incorporated by reference.

It is clear that the patents cited by the Examiner, taken alone or in combination, do not teach, suggest, or describe the subject matter of Applicants' claimed invention.

Inasmuch as each of the rejections has been answered by the above remarks, it is respectfully requested that the rejections be withdrawn, and that this application be passed to issue.

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Amendment

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